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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,255	01/09/2001	Richard N. Spann	RNS-001	6555

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EXAMINER
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NOVOSAD, JENNIFER ELEANORE

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/757,255

Applicant(s)

SPANN, RICHARD N.

Examiner

Jennifer E. Novosad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2003 and 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-26, 28-33, 37-39, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) 31-33, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-26, 28, 39, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This final Office action is in response to the amendment filed August 27, 2003 (Paper No. 17) and September 29, 2003 (Paper No. 19).

#### ***Status of Claims***

Claims 24-26, 28-30, 39, 41, and 42 are pending and claims 31-33, 37, and 38 stand withdrawn as being drawn to a non-elected species.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-26, 28-30, 39, 41, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 is rendered indefinite since it appears that applicant is improperly seeking to link the functionally recited structure of the elongate member to the positively recited structure of the rails through the limitation "for simultaneously contacting and exerting reaction forces on the elongate member" in lines 6-8. *In particular*, it appears that only an elongate member of a certain size and possibly shape would meet this functional limitation of the claim and since the member is being functionally recited the metes and bounds of the claim cannot be properly ascertained. It is noted that if an elongate member having a very small diameter is placed within the "opening" of a device having the structural features of the instant device, while the rails may

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not contact the member, the device would meet the structural limitations of the claim. *Further*, the language of the limitation “to lodge and restrain” in line 8 renders the claim indefinite since this limitation is seeking to improperly link the (functionally recited) member to the (positively recited) rails. Note also line 3 of claim 28. These rejections are also applicable to claims 39 and 42.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 24-26, 28, 39, 41, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenberg ‘081.

Rosenberg ‘081 discloses a freestanding tool holding device (see Figure 2) comprising a first rail (8), a second rail (6) vertically and horizontally offset from the first rail (8) thereby forming an opening therebetween for receiving a lower end (14) therein, i.e., the lower end (14) is inserted into the opening and passed therethrough; the rails defining parallel (see Figure 1) crossbars; the rails (6 and 8) having generally opposed edges, i.e., edge of 8 is facing down in Figure 2 and edge of 6 is facing up, for simultaneously contacting and exerting reaction forces of the member (13) thereby being adapted to lodge and restrain (see column 2, lines 42-51) the member in a generally vertical and leaning orientation whereby the device lacks a base plate to support the lower end of the member (13). *With respect to claim 39*, Rosenberg ‘081 is

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considered to show the structure capable of performing the method steps of providing a freestanding device comprising first (8) and second d (6) rails vertically and horizontally offset from one another for receiving a member therein to lodge and restrain the member.

*With respect to claims 26, 28, 41 and 42, the rails (6 and 8) of Rosenberg '081 comprise at least two depressions, generally aligned for further restraining the member (see column 4, lines 61-64 which states that the "rippled facing edges of the two arms 6, 8, produce concave surfaces which tend to self-center"), i.e., the "concave surfaces" define the depressions .*

*With respect to the limitation "freestanding", in line 1 of claim 24 and line 2 of claim 39, the device of Rosenberg '081 is considered to be a "freestanding" device since the device is not permanently attached to a secondary structure.*

#### ***Allowable Subject Matter***

Claims 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to show or suggest a device, as called for in the claims, and further comprising end plates attached to side edges of the crossbars, as specifically called for in the claimed combination of claim 29.

It is noted that although the prior art, such as Speiser and Pushee, show tool holding devices comprising vertically and horizontally offset rails defining crossbars, and end plates attached to the endplates, Speiser does not lack a base plate for supporting the lower end of the

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member, as called for in claim 24, and Pushee does not have “opposed edges” as called for in claim 24.

***Response to Arguments***

Applicant's arguments with respect to claims 24-26, 28, 39, 41, and 42 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection were necessitated by the amendment reciting “freestanding” in line 1 of claim 24 and line 2 of claim 39, “for simultaneously contacting... lodge and restrain” in lines 6-8 of claim 24 and lines 5-7 of claim 39, and “a base plate” in line 10 of claim 24 and line 11 of claim 39.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872.

The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703)-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.

  
Jennifer E. Novosad  
Primary Examiner  
Art Unit 3634

Jennifer E. Novosad/jen  
December 1, 2003